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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,859	01/23/2006	Neil Colvin Bremner	CAF-34802/03	7420
25006 7590 07/07/2008 GIFTORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021				
EXAMINER MEYER, KATY E				
ART UNIT 3618		PAPER NUMBER		
MAIL DATE 07/07/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,859

**Applicant(s)**

BREMNER, NEIL COLVIN

**Examiner**

Katy Meyer

**Art Unit**

3618

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 6, 18 and 33-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17 and 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed February 15, 2008 have been fully considered but they are not persuasive.

Applicant argues that claim 1 distinguishes over the cited references because the combinations lack teachings of a tubular member adapted to be compressed laterally and a removable cover adapted to cover the exposed surface of the tubular member.

With respect to the arguments relating to compressibility, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in the patentable sense. Fite teaches a golf bag wherein the sidewalls of a tubular member are "adapted to" be compressed laterally if a sufficient force is applied.

Applicant's arguments with respect to a cover adapted to cover the exposed surface of a tubular member are considered moot in view of new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 3, 7 – 12, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carolan (US 4,792,152) in view of Fite (US 2,665,727) and Dunn (US 5,265,894).**

Carolán discloses a golf bag (Fig. 2) having a closed base (22) and a top (20) having an aperture for receiving golf clubs (see Fig. 1), said base and said top being interconnected by a rigid spine (10) and at least one tubular member (30).

Carolán does not disclose a plurality of apertures in the sidewalls of the tubular member or a cover adapted to cover the exposed surface of the tubular member.

Fite teaches a golf bag (Fig. 1) wherein the sidewalls of a tubular member (11) comprise a series of rectangular apertures constituting a mesh construction (see Fig. 2). Said tubular member is capable of being compressed laterally. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the golf bag disclosed by Carolán with the mesh sidewalls taught by Fite to decrease the weight of the bag, and to facilitate the drying of the bag and the clubs it carries (see Fite, column 1, lines 14 – 19 and 46 – 51).

Dunn teaches a cover (11) which covers all exposed surfaces of a golf bag. The cover disclosed by Dunn is capable of being adapted to cover the bag disclosed by Carolán and Fite. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bag disclosed by Carolán and Fite with the cover taught by Dunn to prevent loss or damage to the clubs.

Carolán further discloses a hollow spine member receiving a handle (12). A web portion (26, 28) is located adjacent both the top (see 26) and the base (see 28). A substantial portion of the length of the base is not covered by the web portion (see Figs. 1 – 3). Said top and base are substantially the same shape in plan view.

Dunn further discloses a synthetic or natural, flexible cover (column 2, lines 20 – 27).

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carolan (US 4,792,152) in view of Fite (US 2,665,727) and Dunn (US 5,265,894) as applied to claim 1 above, and further in view of DeMichele (US 6,330,944).**

Carolan, Dunn, and Fite meet all the limitations of the claimed invention, but do not disclose a molding process. DeMichele teaches a golf bag wherein the tubular member is formed by a molding process (column 4, lines 33 – 37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tubular member taught by Carolan and Fite using a molding process taught by DeMichele, as molding is a widely used process for imparting a specified shape and surface structure to a large workpiece.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carolan (US 4,792,152) in view of Fite (US 2,665,727) and Dunn (US 5,265,894) as applied to claim 1 above, and further in view of Lawson (US 6,186,016).**

Carolan, Dunn, and Fite meet all the limitations of the claimed invention, but do not disclose a forming process involving sheet material. Lawson teaches a golf bag wherein the tubular member is formed by joining longitudinal sides of a piece of sheet material (see claim 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tubular member taught by Carolan and Fite using the process taught by Lawson, as it is well known that joining the edges of a piece of sheet material forms a tube.

**Claims 1 – 3, 12 – 17, and 20 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Airey, Jr. (US 4,911,292) in view of Fite (US 2,665,727), Carolan (US 4,792,152), and Dunn (US 5,265,894).**

Airey, Jr. discloses a golf bag (Fig. 2) having a closed base (13) and a top (14) having an aperture for receiving golf clubs (see Fig. 2), said base and said top being interconnected by at least one tubular member (11). Airey, Jr. does not disclose a plurality of apertures in the sidewalls of the tubular member, a spine member, or a cover member that covers the exposed surface of the tubular member.

Fite teaches a golf bag (Fig. 1) wherein the sidewalls of a tubular member (11) comprise a series of rectangular apertures constituting a mesh construction (see Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the golf bag disclosed by Airey, Jr. with the mesh sidewalls taught by Fite to decrease the weight of the bag, and to facilitate the drying of the bag and the clubs it carries (see Fite, column 1, lines 14 – 19 and 46 – 51).

Carolan teaches a rigid spine member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bag disclosed by Airey, Jr. and Fite with the spine member taught by Carolan to increase the stability of the bag.

Dunn teaches a cover (11) which covers all exposed surfaces of a golf bag. The cover disclosed by Dunn is capable of being adapted to cover the bag disclosed by Airey, Jr., Carolan, and Fite. It would have been obvious to one of ordinary skill in the

art at the time the invention was made to make the bag disclosed by Airey, Jr., Carolan, and Fite with the cover taught by Dunn to prevent loss or damage to the clubs.

Airey further discloses a first portion (11) having a base (13) and a top (14) that is in part the same shape as the base, and a second portion (12) having a base (21) and a top (22), which are similar in plan view. The base of the second portion fits in the base of the first portion, and the tops of the first and second portions form a combined shape, which is substantially the same as the base of the first portion (see Fig. 4 and column 3, lines 1 – 3). A latch mechanism (34) holds the tops together (see Figs. 6 – 8). The first and second portions comprise nesting surfaces so that the second portion can be nested within the first portion (see column 3, lines 1 – 3).

**Claims 1 – 3, 19, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 5,632,496) in view of Dunn (US 5,265,894) and Fite (US 2,665,727).**

Nelson discloses a golf bag (Fig. 3) having a closed base (24) and a top (20) having an aperture for receiving golf clubs (see Fig. 8), said base and said top being interconnected by at least one tubular member (16). Nelson further discloses a rigid spine (see Fig. 7).

Nelson does not disclose a plurality of apertures in the sidewalls of the tubular member or a cover that covers the exposed surface of the tubular member.

Fite teaches a golf bag (Fig. 1) wherein the sidewalls of a tubular member (11) comprise a series of rectangular apertures constituting a mesh construction (see Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to make the golf bag disclosed by Nelson with the mesh sidewalls taught by Fite to decrease the weight of the bag, and to facilitate the drying of the bag and the clubs it carries (see Fite, column 1, lines 14 – 19 and 46 – 51).

Dunn teaches a cover (11) which covers all exposed surfaces of a golf bag. The cover disclosed by Dunn is capable of being adapted to cover the bag disclosed by Nelson. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bag disclosed by Nelson and Fite with the cover taught by Dunn to protect the entirety of the bag, not just a front portion.

Nelson further teaches using a removable cover (14) to hold together a second portion (70) and a first portion (12) by said cover (see Fig. 1). Nelson further teaches securing a cover to said bag adjacent said top and on said base (see Fig. 1) using spigots and eyelets (225), see Fig. 21.

**Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carolan (US 4,792,152), Fite (US 2,665,727), and Dunn (US 5,265,894) as applied to claim 1 above, and further in view of Longo.**

Carolan, Fite, and Dunn meet all the limitations of the claimed invention, but do not disclose a plurality of tubular members. Longo discloses a plurality of tubular members (12) and apertures through the top. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bag disclosed by Carolan, Fite, and Dunn with the plurality of tubular members taught by Longo to protect the clubs and prevent them from damaging each other.



**Claims 28 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carolan (US 4,792,152) in view of Fite (US 2,665,727) and Dunn (US 5,265,894) as applied to claim 1 above, and further in view of Fester et al. (US 3,521,897) and Descalo (US 3,351,983).**

Carolan, Dunn, and Fite meet all the limitations of the claimed invention, but do not disclose the claimed wheel assembly. Fester et al. teach an undercarriage (11) having two first class levers (17B, 18B) with a common fulcrum (27), wherein the proximal ends of said levers clamp a fitment when the distal ends of the levers are spaced from each other. Descalo teach a golf bag (Fig. 1) including a fitment (16) allowing an undercarriage to be attached thereto. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a golf bag with the undercarriage taught by Descalo, using the attachment means taught by Fester et al. so that the undercarriage could be removed for when the bag is being carried or stored.

Descalo further discloses wheels (24) rotatably mounted at the distal ends of the levers. The levers are held in a spaced relation to each other by a length-adjustable strut (18). The undercarriage is collapsed by collapsing said strut (18).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katy Meyer whose telephone number is (571)272-5830. The examiner can normally be reached on Monday - Friday, 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher P Ellis/  
Supervisory Patent Examiner, Art  
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/K. M./

Examiner, Art Unit 3618